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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/788,351	02/21/2001	Takayuki Usui	Q61689	1061

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EXAMINER	
AUGHENBAUGH, WALTER	
ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/788,351	Applicant(s) USUI ET AL.	
	Examiner Walter B. Aughenbaugh	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2005 and 29 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 and 26-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 and 26-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 29, 2005 (Amdt. G) has been entered.

Acknowledgement of Applicant's Amendments

2. Applicant's amendments in claims 7 and 23 in the Amendment filed March 29, 2005 (Amdt. G) have been received and considered by Examiner.
3. New claim 29 presented in Amdt. G has been received and considered by Examiner.
4. The cancellation of claim 25 in Amdt. G has been acknowledged by Examiner.

WITHDRAWN OBJECTIONS

5. The objection of claim 21 that was repeated in paragraph 4 of the previous Office Action mailed October 29, 2004 has been withdrawn due to Applicant's amendment in claim 7 in Amdt. G.

WITHDRAWN REJECTIONS

6. The 35 U.S.C. 112 rejection of claims 10-12 that was repeated in paragraph 14 of the previous Office Action mailed October 29, 2004 has been withdrawn due to Applicant's amendment in claim 7 in Amdt. G.

REPEATED REJECTIONS

Claim Rejections - 35 USC § 103

7. The 35 U.S.C. 103 rejections of claims 13-18 and 22 that were repeated in paragraph 15 of the previous Office Action mailed October 29, 2004 have been repeated for the reasons previously made of record.

8. The 35 U.S.C. 103 rejection of claims 1, 2, 7-10, 19-21, 24, 26 and 27 made of record in paragraph 16 of the previous Office Action mailed October 29, 2004 has been repeated for the reasons previously made of record, and for the following reason that addresses the amendment made in claim 7 in Amdt. G: Hayashi et al. teach that the paper having smooth surfaces has a Bekk smoothness of 5 to 10,000 seconds (col. 2, lines 48-54 and col. 8, lines 39-42), a range that overlaps with the claimed range of 3 to 900 seconds. Since the sheet of paper has "smooth surfaces" (col. 2, lines 40 and 45-47 and col. 8, lines 30-39), both surfaces of the sheet have smoothness values that fall within the range of 5 to 10,000 seconds, so the contact surface has a smoothness of 5 to 10,000 seconds, a range that overlaps with the claimed range of 3 to 900 seconds.

9. The 35 U.S.C. 103 rejection of claims 3, 5 and 11 made of record in paragraph 17 of the previous Office Action mailed October 29, 2004 has been repeated for the reasons previously made of record and, in regard to claim 11, for the reason provided above that addresses the amendment made in claim 7 in Amdt. G.

10. The 35 U.S.C. 103 rejection of claims 4, 6 and 12 made of record in paragraph 18 of the previous Office Action mailed October 29, 2004 has been repeated for the reasons previously

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made of record and, in regard to claim 12, for the reason provided above that addresses the amendment made in claim 7 in Amdt. G.

11. The 35 U.S.C. 103 rejection of claim 23 made of record in paragraph 19 of the previous Office Action mailed October 29, 2004 has been repeated for the reasons previously made of record, and for the following reason that addresses the amendment made in claim 23 in Amdt. G: since the proposed combination of Coppens et al., Hayashi et al. and Busch results in the claimed structure (different Bekk smoothnesses of the two surfaces), the different Bekk smoothnesses of the two surfaces of the package sheet structure taught by Coppens et al., Hayashi et al. and Busch necessarily facilitate separation of the packaging material from the planographic printing plate during automatic feeding and prevents damage to the image surface of the printing plate.

12. The 35 U.S.C. 103 rejection of claim 28 made of record in paragraph 20 of the previous Office Action mailed October 29, 2004 has been repeated for the reasons previously made of record.

NEW REJECTIONS

Claim Rejections - 35 USC § 103

13. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coppens et al. and Hayashi et al.

Hayashi et al. teach that the paper having smooth surfaces has a Bekk smoothness of 5 to 10,000 seconds (col. 2, lines 48-54 and col. 8, lines 39-42), a range that encompasses the claimed range of 250 to 900 seconds. Given that the sheet of paper has “smooth surfaces” (col. 2, lines 40 and 45-47 and col. 8, lines 30-39), Examiner interprets the use of the plural form of “surface” to indicate that both surfaces of the sheet of paper have a degree of smoothness as quantified by the

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stipulated Bekk smoothness range of 5-10,000. Therefore, one of ordinary skill in the art would have recognized to have used paper as the paper spacer of Coppens et al. that has surfaces having a Bekk smoothness of 5 to 10,000 seconds, a range that encompasses the ranges of 250 to 900 seconds for the contact surface, since Bekk smoothness values of from 5 to 10,000 seconds for paper are well known suitable smoothness values for packaging photographic sheet material as taught by Hayashi et al. Since the proposed combination of Coppens et al. and Hayashi et al. results in the claimed structure, the imaging surface of the planographic printing plate is necessarily not damaged during the separation of the printing plate from the packaging material.

Response to Arguments

14. Applicant's arguments presented on pages 10-11 of Amdt. G regarding the 35 U.S.C. 112, first paragraph rejection of claims 10-12 that was repeated in paragraph 14 of the previous Office Action mailed October 29, 2004 are moot due to the withdrawal of this rejection in this Office Action.

15. Applicant's arguments presented on pages 12-17 of Amdt. G regarding the 35 U.S.C. 103 rejection of claims 1, 2, 7-10, 13-16, 18-22 and 24-27 over Coppens et al. in view of Hayashi et al. in view of Usui have been fully considered but are not persuasive.

Applicant argues that there is no motivation to combine the references because "the density of an interleaf is not linked to the stabilization of the sensitivity of the photosensitive printing plate material" (page 14 of Amdt. G; it is stated in paragraph 16 of the previous Office Action that "one of ordinary skill in the art would have recognized to have synthesized the sheets taught by Coppens et al. and Hayashi et al. with the density specified by Usui in order to provide a paper capable of effectively protecting the printing plate and to enable stabilization of the

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sensitivity of the photosensitive printing plate material in a short period of time as taught by Usui”). While Usui may not explicitly link the density of an interleaf to the stabilization of the sensitivity of the photosensitive printing plate material as Applicant’s argue, whereas air permeability is explicitly linked to the stabilization of sensitivity at col. 2, lines 35-41, density is necessarily linked to air permeability because the interleaf having a density of 0.8 g/cm^3 of Embodiment 1 of Usui (col. 2, lines 51-62) necessarily has an air permeability that falls within the required range of Usui of between about 15 seconds and about 300 seconds because it is disclosed as an embodiment of the invention. Therefore, one of ordinary skill in the art would have recognized that a variation in the density of a bleached kraft pulp/water mixture would have resulted in a variation of the air permeability of the resultant interleaf and would have been motivated to vary the density of the bleached kraft pulp/water mixture in order to achieve the desired air permeability of the resultant interleaf.

On page 14 of Amdt. G, Applicant refers to, and repeats, an argument presented on pages 12-16 of the Amendment filed July 30, 2004. The Office’s response to this argument is in the paragraph bridging pages 14 and 15 of the previous Office Action mailed October 29, 2004. In response to Applicant’s argument that the three patents relied upon in the rejection are intended to store different items, and therefore the three references cannot be combined, the Office repeats that which is stated in the paragraph bridging pages 14 and 15 of the previous Office Action mailed October 29, 2004 and also notes that the particular item that is intended to be stored in any of the packages of the three references is a matter of intended use, and one of ordinary skill in the art would have recognized to have varied the properties of the particular interleaf in order to accommodate the particular item that is intended to be stored.

In response to Applicant's argument on page 16 of Amdt. G that "[I]n Hayashi, however, the smoothness is considered for a different purpose", the fact that Applicant uses the smoothness values for a different purpose does not alter the conclusion that its use in a prior art device would be *prima facie* obviousness from the purpose disclosed in the reference. *In re Lintner*, 173 USPQ 560. Applicant argues that "[i]f an interleaf sheet of Hayashi is applied to the invention of Coppens, air permeability will be excessively large and stability of sensitivity will not be maintained", but this unsupported argument does not address the proposed combination of references at issue of Coppens et al., Hayashi et al. and Usui.

16. Applicant's arguments presented on page 18 of Amdt. G regarding the 35 U.S.C. 103 rejections of claims 3-6, 11, 12 and 17 have been fully considered but are not persuasive. Applicant's arguments depend entirely upon Applicant's arguments regarding the 35 U.S.C. 103 rejection of claims 1, 2, 7-10, 13-16, 18-22 and 24-27 over Coppens et al. in view of Hayashi et al. in view of Usui, which have been addressed above in this Office Action.

17. Applicant's arguments presented on pages 18-20 of Amdt. G regarding the 35 U.S.C. 103 rejection of claim 23 have been fully considered but are not persuasive. In response to Applicant's arguments regarding "facilitating separation [equivalently, "peelability"] and preventing damage to the printing material", since the proposed combination of Coppens et al., Hayashi et al. and Busch results in the claimed structure (different Bekk smoothnesses of the two surfaces), the different Bekk smoothnesses of the two surfaces of the package sheet structure taught by Coppens et al., Hayashi et al. and Busch necessarily facilitate separation of the packaging material from the planographic printing plate during automatic feeding and prevents damage to the image surface of the printing plate.

Applicant's statement that "[i]f an interleaf sheet of Hayashi is applied to the invention of Coppens, air permeability will be excessively large and stability of sensitivity will not be maintained" is unsupported. Applicant's statement that "[i]f a sheet of Hayashi is applied to the printing plate system as set forth in claim 23, the smoothness will be excessively large and peelability will considerably deteriorate" is also unsupported, and is not directed to the proposed combination of references at issue of Coppens et al., Hayashi et al. and Busch. Applicant argues that Busch cannot be combined with Coppens et al. and Hayashi et al. because Busch does not pertain to "a packaging material or a planographic plate", but one of ordinary skill in the art would have been motivated to consult Busch because Busch pertains to coated paper, and Hayashi et al. disclose that coated paper is a suitable kind of paper for the sheet of paper (col. 2, lines 39-42) as stated in paragraph 19 of the previous Office Action mailed October 29, 2004: Busch goes into some detail about the formation and composition of coated paper.

18. Applicant's arguments presented on pages 20-22 of Amdt. G regarding the 35 U.S.C. 103 rejection of claim 28 have been fully considered but are not persuasive. Applicant argues that there is no teaching in Coppens et al. that the paper spacer is a means for preventing peeling of the imaging surface of the planographic printing plates, but the paper spacer is necessarily a means for preventing peeling of the imaging surface of the planographic printing plates insofar as the paper spacer separates the imaging surface of one plate from the non-imaging surface of another plate, reducing damaging frictional interactions between those two surfaces while the imaging surface is fed through the feeding mechanism. Applicant's statement that "[i]f an interleaf sheet of Hayashi is applied to the printing plates of Coppens, air permeability will be excessively large and stability of sensitivity will not be maintained" is unsupported. Applicant's

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statement that “[i]f a sheet of Hayashi is applied to the printing plate system as set forth in claim 28, the smoothness will be excessively large and peelability will considerably deteriorate” is also unsupported, and is not directed to the proposed combination of references at issue of Coppens et al. and Hayashi et al.

Conclusion


19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 571-272-1488. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Walter B. Aughenbaugh
09/19/05

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1772

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